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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/386,605

08/31/1999

CHRISTOPHER G. TAYLOR

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07/18/2006

MONSANTO COMPANY

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ST. LOUIS, MO 63167

EXAMINER

HELMER, GEORGIA L

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/386,605	Applicant(s) TAYLOR ET AL.	
	Examiner Georgia Helmer	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. The Office acknowledges receipt of Applicants Response; dated 20 April 2006.
2. Applicant has canceled claim 5, and amended claim 1. Claims 1, and 8-11 are pending, and are examined in the instant action.
3. This action is made FINAL.
4. All rejections not addressed below have been withdrawn.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Applicant statement (Response, p. 3, 1st ¶) thanking "the Examiner for providing an indication that the claims are free of the prior art" is factually incorrect. **The Examiner has not made any indication of the instant claims being free of the prior art.** Rather, the Office has maintained prior art rejections throughout the prosecution of the instant case.

Priority

7. For the reasons set forth in the Office Action mailed 20 October 2005, repeated in part below:

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed (60/098,402) fails to provide adequate support under 35 U.S.C. 112 for claims 1, and 8-11 of this application. Accordingly, Applicant shall have benefit of the date of filing of the non-provisional Application, 31 August 1999.

Since the claimed method is directed toward subject matter not disclosed in the provisional application, Applicant shall have priority benefit of the date of filing of the non-provisional application, 31 August 1999.

Applicant traverses saying primarily (Response, p. 5) that enablement and written description support are found in the provisional application, and requests specific details.

Applicant's traversal is unpersuasive. **Specifically lacking support are:**
the hypocotyl explant having a cut end below the cotyledon (claim 1, line 4) and to produce the chimeric dicot plant having transformed roots and wild-type shoots stems and leaves (claim 1, lines 9 and 10). See provisional application p.40.

Applicant traverses primarily (Response, p. 3) "the Applicants believe the presently amended claims are sufficiently supported by the originally filed provisional Application."

Applicant's traversal is unpersuasive. Applicant offers no evidence to support their statement above. Accordingly Applicant shall have priority benefit of the date of filing of the non-provisional application, 31 August 1999.

Claim Rejections - 35 USC § 103

8. Claims 1 and 8-11 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tulson et al (EP 0262972 A2 published April 6, 1988), in view of Simpson et. al. (1986) Plant Mol. Biol. vol 6, pages 403-415 and Savka et. al. (1990) Phytopathology vol 80, pages 503-508. To the extent that this is a new rejection, it is necessitated by Applicant's amendment.

Applicant traverses primarily (Response, p. 3, 3rd ¶) that "Tulson teaches the transformation of cucumber hypocotyls via infection with rhizogenes. Tulson does not teach the use of soybean. To account for this deficiency, the Examiner cites Simpson and Savka, which report the susceptibility of certain soybean tissue to rhizogenes. But neither reference teaches or suggests the use of soybean hypocotyls or stems."

Applicant's traversal is unpersuasive. As stated in the Office Action mailed 20 October 2005:

Tulson teaches a method of producing a stably transformed chimeric cucumber having transgenic root tissue. Tulson et al teach obtaining a hypocotyl explant (page 5, lines 50-60), inoculating with Agrobacterium rhizogenes (page 5, lines 52-55), culturing (page 5, lines 52-55), and producing plants (page 6, lines 1-15). Tulson teaches obtaining an explant (page 5, lines 30-40) where the explant is a hypocotyl with the cut end below the cotyledon. Tulson teaches the cut end of the hypocotyl being contacted with Agrobacterium rhizogenes (page 5, lines 52-55). Tulson teaches placing the inoculated hypocotyl on a medium containing MS (page 6, lines 4-6). Tulson teaches placing the inoculated hypocotyl on a medium containing MS and a selectable agent. (Page 6, lines 7 and 8). Tulson teaches using kanamycin wherein the concentration of kanamycin in the media is 25 mg/L (page 7, lines 22-28), which is less than 50 mg/l. (p. 7 of Office Action) [emphasis added].

Applicant further traverses that neither reference (Simpson or Savka) teaches or suggests the use of soybean hypocotyl or stems; and that there is no reasonable expectation of success in taking information from cucumber transformation and applying it to soybeans.

Applicant's traversal is unpersuasive. Simpson et. al. (1986) Plant Mol. Biol. vol 6, pages 403-415, teach the Agrobacterium Rhizogenes transformation of soybean to produce transformed roots from soybean stem sections or hypocotyls (p. 409, Table 2). See Office Action of 20 October 2005, p. 8.

Savka et. al. (1990) Phytopathology vol 80, pages 503-508, teach that Agrobacterium Rhizogenes K599 is "by far the most effective in inducing hairy roots in soybean" (p. 506 ¶ bridging to p. 507). See Office Action of 20 October 2005, p. 8.

Thus the claimed invention would have been prima facie obvious as a whole to one of ordinary skill in the art at the time it was made, especially in the absence of

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evidence to the contrary. Accordingly, the claimed invention is prima facie obvious in view of the prior art

Remarks

9. No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia Helmer whose telephone number is 571-272-0796. The examiner can normally be reached on 10-6 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Georgia Helmer PhD
Patent Examiner
Transgenic plants - art unit 1638
6 July 2006

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